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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

BAR01423P00050US

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on September 4, 2008

Signature

Typed or printed
name

Karen A. Sanderson

Application Number

10/647,916

Filed

August 26, 2003

First Named Inventor

Joachim Tiemann et al

Art Unit

3635

Examiner

Basil S. Katcheves

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 29,141☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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Telephone number

September 4, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 2 forms are submitted.

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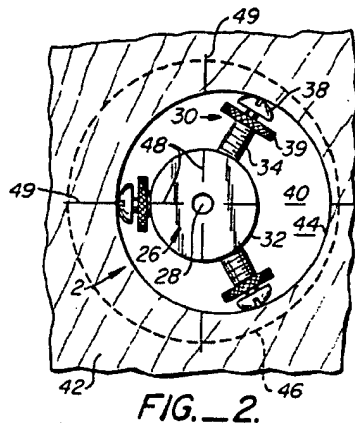
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STATEMENT FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1, 2, 4, 5, 22-26, 28 and 29 are pending. All of the pending claims have been rejected under 35 U.S.C. §102(b) over Damico U.S. Patent No. 4,579,486. Applicant respectfully traverses this rejection of the claims.

The present invention as disclosed and claimed relates to a dowel structure used to assemble an insulating plate onto a substructure. This invention allows for deepened mounting of the dowel in insulating material.



By contrast, Damico discloses a simply constructed hole saw guide for cutting a new hole in a work piece, where the new hole partially overlaps or surrounds an existing hole in the work piece (column 1, lines 36-40 and Fig. 1 at right). That is, as best illustrated in Fig. 2, the Damico guide 2 is located inside an existing hole 40 with the three guide arms 30 variously extended to engage the inner circumferential surface 44 of the hole 40 so as to position the guide hole 28 (eccentrically in Fig. 2) relative to the center of the hole 40 so that a different eccentric hole 46 can be cut by the lower cutting edge 8 of the hole cutting assembly 4 (see Fig. 1)

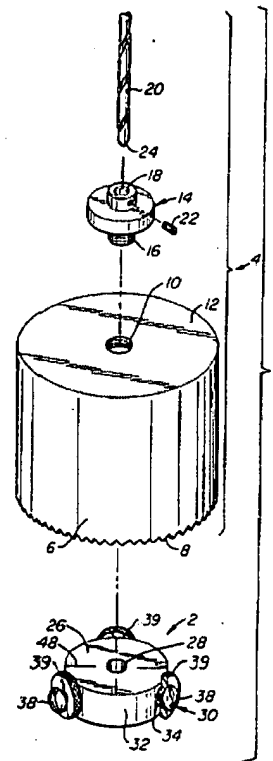


Fig. 1

The advantage of the Damico hole saw guide is that it does not require extraordinary clamping and guiding means as would otherwise be required (column 1, lines 59-63), with the guide being especially useful if a hard material such as metal is cut in order to prevent the hole saw from walking around the work piece when starting to cut a hole (column 1, lines 19-26).

This Damico hole saw/hole saw guide does not represent a dowel, as asserted by the Final Office Action in rejecting the claims. This hole saw belongs to an entirely different technical field (Int. Cl. B23B 49/00 versus Int. Cl. E04F 13/08 for the inventive dowel). Moreover, whereas a dowel is a device which is used to hold components together, Damico is a device used merely to cut a hole in one component. It does not hold two components together, it not intended to hold two components together, but instead is merely one component (a saw) which is used to cut a second component (the workpiece) after which the two components are permanently separated. That is, the entire structure of the Damico device is removed from the hole location after the hole is cut which is certainly not something which would thereafter hold separate components together like a dowel).

Simply put, (1) Damico is a drill structure only and would simply not be considered by the person skilled in the art when addressing dowels, and (2) Damico teaches nothing relevant to use of a dowel to connect two components together.

The hindsight matching of a few components of the claimed invention to components of the completely different Damico device cannot and would not teach the

claimed invention. Moreover, the claims clearly recite differences from the Damico structure, making the 35 U.S.C. §102(b) rejection inappropriate:

1. The top 12 of the Damico hole saw is not a pressing plate of a dowel such as recited in all of the claims (e.g., "dowel (1) having a pressing plate (13)" in claim 1). The top 12 of the saw is clearly not intended to press anything. To the contrary, the end 24 of the pilot drill 20 is specifically mounted to extend below that saw top 12 (col. 2, lines 24-27) and thus would **prevent** the saw top 12 from pressing against anything. That is, rather than being intended to be a pressing plate, it is intended to **not** be a pressing plate.
2. Also contrary to the assertion in the Office Action, the threaded hole 10 in Damico is not in any way a dowel sleeve arranged at the pressing plate in order to receive an expansion element as recited in the claims. Rather, the threaded hole 10 in Damico receives the threaded end 16 of a mandrel 14 is secured to the pilot drill 20 (by set screw 22).
3. Still further contrary to the assertion in the Office Action, the saw top 12 is also not an "expansion element head" (as variously recited in all the independent claims). Neither does the hole 10 in Damico include an expansion zone as also recited in the claims (e.g., all of the independent claims recite that "the dowel sleeve (15) comprises an expansion zone (18)"). Damico's saw top 12 does not involve expansion of any sort.

In summary, Damico is a completely different structure from the claimed invention, with a few similar elements. Despite those few similar elements, the structure

as claimed is clearly different whereby the independent claims are all novel over Damico. Moreover, the Damico and claimed structures are so fundamentally different that the differences recited in the claims could not in any way be said to be obvious modifications of the structure. There is nothing in the Damico *cutting saw* which would translate in any meaningful way in the manner taught by Applicant's invention to provide a deepened mounting of dowels in insulating material.

Accordingly, all of claims 1, 2, 4, 5, 22-26, 28 and 29 are respectfully submitted to be allowable.